

REMARKS

Claims 1, 119, 125, 127-129 and 131-134 are pending in the application. Claim 1 has been amended to further clarify the present invention. Support for the word “independently” can be found implicitly throughout the specification, in particular figure 1, in which the biological species is attached to a surface, and an oligonucleotide tag is also attached independently to another part of the same surface. Support for newly added claims 133 and 134 can be found throughout the specification, in particular at pages 3 and 4 in the specification. No new matter has been inserted into the application.

Rejection Under 35 U.S.C. §112: First Paragraph

Claim 131 has been rejected under 35 U.S.C. §112, first paragraph as failing to comply with the written description requirement. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

The Examiner objects to the language “deactivating”. However, the presently amended claim 131 recites “separating”, which finds ample support in the specification. Accordingly, this rejection has been overcome.

Rejection Under 35 U.S.C. §112: Second Paragraph

Claim 1 and 119-131 have been rejected under 35 U.S.C. §112, second paragraph as being indefinite. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

The claims have been amended to incorporate “immobilized” in place of “fastened”.

The claims have been amended to further clarify the presently claimed invention. It is believed that this rejection has been overcome.

Rejection Under 35 USC § 102(b) Over Mirkin ‘740 (WO 98/04740)

Claims 1 and 119-131 have been rejected under 35 U.S.C. § 102(b) as being anticipated by Mirkin ‘740. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Mirkin ‘740 discloses a surface on which is bound an oligonucleotide. An analyte oligonucleotide, which is free floating bonds to the oligonucleotide that is bound to the surface. However, Mirkin ‘740 fails to disclose or suggest an analyte which is bound to the surface and independently, an oligonucleotide identifier bound to the same surface on which is bound the biological species. Therefore, Mirkin ‘740 fails to anticipate the presently claimed invention.

Rejection Under 35 U.S.C. §103(a) Over Mirkin ‘740 (WO 98/04740) In View Of Sigal ‘670 (U.S. Patent No. 6,319,670)

Claims 123, 125, 129-131 have been rejected under 35 U.S.C. §103(a) as being “obvious” over Mirkin ‘740 in view of Hunkapiller ‘609. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Mirkin ‘740 is discussed above.

Sigal ‘670 discloses a self-assembled monolayer.

Mirkin ‘740 fails to disclose or suggest an independent attachment of the biological species and separately an oligonucleotide identifier on the same surface. Sigal ‘670 fails to

remedy the deficiencies in Mirkin '740 because Sigal '670 discloses only the use of self-assembled monolayer. Therefore, the combination of these references fails to arrive at the presently claimed invention. Therefore, the presently claimed invention is not obvious over the cited references.

Rejection Under 35 U.S.C. §103(a) Over Mirkin '740 (WO 98/04740) In View Of Hunkapiller'609 (U.S. Patent No. 5,942,609)

Claims 123, 125, 129-131 have been rejected under 35 U.S.C. §103(a) as being "obvious" over Mirkin '740 in view of Hunkapiller '609. Applicant traverses this rejection. Reconsideration and withdrawal thereof are respectfully requested.

Mirkin '740 is discussed above.

Hunkapiller '609 discloses a "bridging nucleotide method". Hunkapiller '609 also discloses identifying the ligation product via sanger dideoxy DNA sequencing and/or real time PCR.

Mirkin '740 fails to disclose or suggest independently attaching a biological species on a surface together with an oligonucleotide identifier, which is attached to the common surface in an independent manner. In view of this deficiency in Mirkin '740, Hunkapiller '609 fails to remedy the deficiencies noted in Mirkin '740, in failing to disclose or suggest independent placement of the biological species and the oligonucleotide identifier on the same surface. Accordingly, the combination of Mirkin '740 and Hunkapiller '609 fails to arrive at the presently claimed invention. Accordingly, the presently claimed invention is not obvious over the cited references.

Conclusion

It is believed that the application is now in condition for allowance. Applicants request the Examiner to issue a notice of Allowance in due course. The Examiner is encouraged to contact the undersigned to further the prosecution of the present invention.

The Commissioner is authorized to charge JHK Law's Deposit Account No. **502486** for any fees required under 37 CFR § 1.16 and 1.17 and to credit any overpayment to said Deposit Account No. **502486**.

Respectfully submitted,

JHK Law

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